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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,630	05/26/2000	Robert McKinnon JR.	5925.36003	7855

21000 7590 12/12/2005

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EXAMINER

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ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/579,630
Filing Date: May 26, 2000
Appellant(s): MCKINNON, ROBERT

MAILED
DEC 12 2005
Group 3700

Geoffrey Mantooth (Reg. No. 32,042)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 2, 2005 appealing from the Office action mailed February 18, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. In addition to the rejections set forth in the Office Action mailed February 18, 2005, new grounds of rejection are applied to all pending claims.

NEW GROUND(S) OF REJECTION

To the degree it is argued that the compression molding of the claimed invention imparts structure to the claimed lid, the following new grounds of rejection are applied to the claims:

(a) Claims 5, 6, 13, 18-35, 39, 40, 42, 44 and 59-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Marthaler (U.S. 5,755,350). Hauffe et al. teaches a molded plastic lid 31. Hauffe et al. does not teach that the lid could be compression molded. Marthaler teaches that injection molding, blow molding, thermo molding and compression molding are "conventional manufacturing processes" (col. 3 lines 22-26). Marthaler also teaches that it is well known to mold container components using one of these "conventional manufacturing processes", such as

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compression molding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lid of Hauffe et al. made by compression molding, as taught by Marthaler, since it is considered a well known, conventional manufacturing process.

Regarding claims 20-24, 26-35, 42, 61 and 63-65, Hauffe et al. discloses the claimed invention except for the triangular shaped recess. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with a recess having a triangular cross section, in order to give the article a more decorative appearance.

Regarding claim 42, Hauffe et al. also does not disclose the density of the material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with the density of the material being in the range of .938-.942, since it has been held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Regarding claim 44, Hauffe et al. also does not disclose the density of the material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with the density of the material being in the range of .938-.942, since it has been held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Regarding claims 66-68, 70, 71 and 73, Hauffe et al. also does not teach the thickness of the article. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with the thickness being at least 1.5 inches or no greater than two-thirds of the member thickness, since it has been held that "where the general conditions of a claim

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are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

(b) Claims 1, 3, 4, 9, 12, 15-17, 37 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586) and Marthaler (U.S. 5,755,350). Hauffe et al. teaches a lid 31, with recesses shown at number “31” in figure 2. Hauffe et al. does not teach that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses and that the lid is compression molded. Goodwin teaches that it is known to provide a lid with smaller recesses such that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses (see figure 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lid of Hauffe et al. with smaller recesses such that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses, as taught by Goodwin, in order to increase the strength of the lid.

Marthaler teaches that injection molding, blow molding, thermo molding and compression molding are “conventional manufacturing processes” (col. 3 lines 22-26). Marthaler also teaches that it is well known to mold container components using one of these “conventional manufacturing processes”, such as compression molding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lid of Hauffe et al. made by compression molding, as taught by Marthaler, since it is considered a well known, conventional manufacturing process.

(c) Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586) and Marthaler (U.S. 5,755,350), as applied to claim 1 above, and further in view of Bonnema et al. (U.S. 4,726,490). Hauffe et al. discloses the claimed invention except for the wedges. Bonnema et al. teach that it is known to provide a lid with wedges (see

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elements 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified lid of Hauffe et al. having wedges, as taught by Bonnema et al., in order to provide additional means with which the lid may be secured to the container.

(d) Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Marthaler (U.S. 5,755,350), as applied to claim 5 above, and further in view of Bonnema et al. (U.S. 4,726,490). The modified device of Hauffe et al. discloses the claimed invention except for the wedges. Bonnema et al. teach that it is known to provide a lid with wedges (see elements 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified lid of Hauffe et al. having wedges, as taught by Bonnema et al., in order to provide additional means with which the lid may be secured to the container.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3,921,449	HAUFFE et al.	11-1975
5,564,586	GOODWIN	10-1996
4,726,490	BONNEMA et al.	02-1988
5,755,350	MARTHALER	05-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(a) Claims 5, 6, 13, 18, 19, 25, 39, 40, 59, 60, 62, 69, 72, 74 and 75 have been rejected under 35 U.S.C. 102(b) as being anticipated by Hauffe et al. (U.S. 3,921,449). Hauffe et al. teaches a lid 31, with recesses shown at number "31" in figure 2.

(b) Claims 1, 3, 4, 9, 12, 15-17, 37 and 58 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586). Hauffe et al. teaches a lid 31, with recesses shown at number "31" in figure 2. Hauffe et al. does not teach that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses. Goodwin teaches that it is known to provide a lid with smaller recesses such that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses (see figure 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lid of Hauffe et al. with smaller recesses such that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses, as taught by Goodwin, in order to increase the strength of the lid.

(c) Claim 2 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586), as applied to claim 1 above, and further in view of Bonnema et al. (U.S. 4,726,490). Hauffe et al. discloses the claimed invention except for the wedges. Bonnema et al. teach that it is known to provide a lid with wedges (see elements 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified lid of Hauffe et al. having wedges, as taught by Bonnema et al., in order to provide additional means with which the lid may be secured to the container.

(d) Claim 7 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Bonnema et al. (U.S. 4,726,490). Hauffe et al. discloses the claimed invention except for the wedges. Bonnema et al. teach that it is known to provide a lid with wedges (see elements 45). It would have been obvious to one having ordinary skill in the art at the time the invention

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was made to provide the lid of Hauffe et al. having wedges, as taught by Bonnema et al., in order to provide additional means with which the lid may be secured to the container.

(e) Claims 20-24, 26-35, 42, 61 and 63-65 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449). Hauffe et al. discloses the claimed invention except for the triangular shaped recess. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with a recess having a triangular cross section, in order to give the article a more decorative appearance.

Regarding claim 42, Hauffe et al. also does not disclose the density of the material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with the density of the material being in the range of .938-.942, since it has been held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

(f) Claim 44 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449). Hauffe et al. does not disclose the density of the material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with the density of the material being in the range of .938-.942, since it has been held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

(g) Claims 66-68, 70, 71 and 73 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449). Hauffe et al. discloses the claimed invention except for the thickness of the article. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with the thickness being at least 1.5 inches or no greater than two-thirds of the member thickness, since it has been held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

(10) Response to Argument

(a) *The claims set forth that the lid is compression molded.*

Appellant argues that Hauffe does not teach that the lid is compression molded. The limitation regarding the compression molding of the lid is a process limitation within a product claim. The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

To the degree it is argued that the compression molding process limitation imparts structure to the claimed lid, the new grounds of rejection recited above are applied to the pending claims. The new grounds of rejection use the secondary reference of Marthaler to show that compression molding is considered a well known conventional molding process in the manufacture of container elements.

(b) *The claims set forth that the lid can withstand a load of at least 8000 pounds.*

Appellant also argues that Hauffe does not teach that the lid is capable of withstanding a load of at least 8000 pounds. It is the examiner's position that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (*Hewlett Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). Thus, if a prior art structure is capable of performing the intended use as recited in the preamble, or elsewhere in a claim, then it meets the claim.

In the new grounds of rejection, the modified Hauffe device would inherently have the strength set forth in the claim, since they are structurally similar and made by the same method.

In addition, the limitation that the lid is capable of withstanding a force of at least 8000 pounds is not supported by the claimed structure. The type of plastic and dimensions of the lid are necessary components to properly support the strength limitation. These necessary components are not set forth in the claim.

(c) The claims set forth that the lengths of the elongated edges of the recesses are greater than one half of the "given dimension" of the member.

Since the "given dimension" of the member has not been defined, the recesses of Hauffe meet this limitation. The "given dimension" of the member is not limited to the overall length of the member, and could be any length equal to or less than the overall length of the member.

(d) The claims set forth that a second recess has dimensions greater than the dimensions of the shorter edges of the one recess.

Figure 2 of Hauffe shows several differently sized rectangular recesses which meet this limitation.

(e) Claim 69 sets forth that some recesses are spaced apart from each other a distance greater than the depth of the recesses.

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Hauffe teaches this because recesses on opposite sides of the lid are spaced greater than the depth of the recesses.

(f) *Motivation for combining Hauffe and Goodwin.*

The motivation to reduce the area of the recesses is found within the level of ordinary skill in the art. Increasing the areas of the lid with a greater thickness increases the strength of the lid, since more material is provided in the lid.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above.

Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

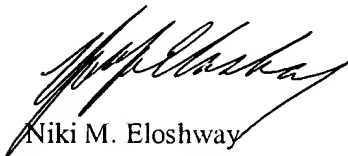
(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply

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brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).


Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,




Niki M. Eloshway

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:




Richard Bertsch, Director TC 3700

Conferees:



Nathan Newhouse, SPE AU 3727



Jes Pascua, Primary Examiner AU 3727

nme